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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,924	12/21/2001	James Earl Mathis	PF02253NA	5055
20280	7590	12/27/2004	EXAMINER	
MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			PEREZ, ANGELICA	
			ART UNIT	PAPER NUMBER
			2684	

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/036,924

Applicant(s)

MATHIS, JAMES EARL

Examiner

Angelica M. Perez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07/27/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-4, 7-8, 10-11 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Maggenti et al. (Maggenti, US 2002/0,086,665 A1).

Regarding claim 1, Maggenti teaches of a method for conducting a group call among communication devices based on presence information of the communication devices (paragraphs 10 and 46; where the method deals with group calls), the method comprising the steps of: displaying presence information at a particular communication device (par. 101 and 121; e.g., "who and how many users are either active or inactive..." corresponds to "presence information"), the particular communication device having access to a contact list that identifies members of the group call (par.101, lines

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7-11), the presence information including a presence status for each of the members of the group call (pars. 101 and 121; e.g., "who and how many users are either active or inactive..." corresponds to "presence information" where "active" and "inactive" correspond to "presence status"); detecting activation of a push-to-talk- button at the particular communication device while the presence information is monitored at the particular communication device (par. 101, lines 7-13 and par. 122; "at any time, the user may request permission to speak to the net by depressing the PTT button..."; where "any time" includes "while". The specification reads "the user monitors the presence status until the desired talk group or individual is available. At step 430, the user presses the push-to-talk button or otherwise..." where the depressing of the push-to-talk button is done as a step of the process and not specifically as a action occurring while monitoring the information); and establishing the group call among the communication devices based on the contact list of the particular communication device (par 10; where establishing group call among the communication devices based on the contact list is a goal of the invention), where a communication link is established with each of the members of the group call (par. 41, 46, lines 12-17; where the call "set-up" from one member to each of the other members of the group is performed by the communications manger. Also, par. 175; e.g., "a participating CD 352 signals a user's desire to broadcast media to the net by issuing a PTT..."; where the message is sent as soon as the PTT button is pressed).

Regarding claim 2, Maggenti teaches all the limitations of claim 1. Maggenti further teaches the step of creating the contact list associated with the particular

communication device before the step of displaying the presence information at the particular communication device, where the contact list identifies the members of the group call (paragraphs 58, 59 and 90).

Regarding claim 3, Maggenti teaches all the limitations of claim 1. Maggenti further teaches where the particular communication device accesses the contact list from a database maintained by the particular communication device (paragraph 97; e.g., "each CD maintains a database, also known as the group-list...").

Regarding claim 4, Maggenti teaches all the limitations of claim 1. Maggenti further teaches where the particular communication device accesses the contact list from a database maintained by a network infrastructure in wireless communication with the particular communication device (paragraph 117; e.g., "the user may command the CD to query the database 232 of the CM 104...for receiving updates to its group-list...").

Regarding claim 7, Maggenti teaches all the limitations of claim 1. Maggenti further teaches the step of indicating that the group call has been established (paragraph 40; e.g., "the requesting user is granted the transmission privilege...notified by an audible, visual or tactile alert...").

Regarding claim 8, Maggenti teaches all the limitations of claim 7. Maggenti further teaches where the step of indicating that the group call has been established includes the step of signaling to the particular communication device to provide a voice message (paragraphs 40 and 200; e.g., "after the requesting user has been granted the transmission privilege...information may be then transmitted to that user to the other net member"; "...provides an indication to that user may begin talking...").

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Regarding claim 10, Maggenti teaches all the limitations of claim 1. Maggenti further teaches the step of detecting a de-activation of the group call at the particular communication device (par.149).

Regarding claim 11, Maggenti teaches all the limitations of claim 1. Maggenti further teaches where the step of detecting a de-activation of the group call includes the step of detecting a release of a push-to-talk button at the particular communication device (par.149; e.g., " a PTT release message is sent by the CD...when the user releases the CD 352 push-to-talk button")

Regarding claim 14, Maggenti teaches all the limitations of claim 1. Maggenti further teaches where the particular communication device includes an instant messaging application and the contact list is accessed by the instant messaging application (paragraphs 38 and 39).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 9 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Maggenti in view of Strom (Strom et al.; EP Pub. No.: EP 1,182,895 A1).

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Regarding claim 6, Maggenti teaches all the limitations of claim 5.

Maggenti does not specifically teach where the step of establishing the group call occurs while the push-to-talk button is still activated.

In related art, concerning a method and apparatus for performing digital voice dispatch calls, Strom teaches where the step of detecting activation of the group call includes the step of detecting an activation of a push-to-talk button at the particular communication device (column 2, paragraph 9; e.g., "dispatch request can be done by pressing a...push-to-talk button...a single communication unit initiates voice...to a group of units").

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Maggenti's method of communication based on presence contact list with Strom's activation detecting based on a push-to-talk button in order to minimize communication delays, as taught by Strom.

Regarding claim 9, Maggenti teaches all the limitations of claim 1.

Maggenti does not specifically teach the step of detecting a voice message at the particular communication device that is directed to the other members of the group call.

In related art, concerning a method and apparatus for performing digital voice dispatch calls, Strom teaches teach the step of detecting a voice message at the particular communication device that is directed to the other members of the group call (column 8, paragraph 0049; e.g., "voice data is included (313)").

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Maggenti's method of communication based on

presence contact list with Strom's detecting a voice message in order to indicate that the communication device is transmitting, as taught by Strom.

5. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over in view Maggenti of (MPEP 2144.03).

Regarding claim 12, Maggenti teaches all the limitations of claim 10.

Maggenti does not specifically teach the step of terminating the group call among the communication devices.

However, Examiner takes "Official Notice" of the fact that terminating the group call among the communication devices is part of a regular communication procedure.

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Maggenti's method of communication based on presence contact list with the step of terminating the group call among the communication devices in order to complete a communication cycle.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mortensen in view of Töyrylä et al. (Töyrylä, US Patent No.: 5,970,417 A).

Regarding claim 13, Maggenti teaches all the limitations of claim 12.

Maggenti does not specifically teach where the step of terminating the group call includes the step of disconnecting the communication link with each of the members of the group call.

In related art, concerning a method for maintaining a group call, Töyrylä teaches where the step of terminating the group call includes the step of disconnecting the



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communication link with each of the members of the group call (column 12, lines 19-25; where the group call is terminated corresponding to "disconnecting the communication link with each of the members of the group call").

It would have been obvious to a one of ordinary skill in the art at the time the invention was made to combine Maggenti's method of communication based on presence contact list with Töyrylä's termination of the group call in order to delete the information related with the call and maintain an updated table, as taught by Töyrylä.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Regarding argument (A), applicant introduces limitation, "push-to-talk"

In response to argument (A), examiner has introduced Maggenti's art that deals with "push-to-talk" devices in order to overcome the limitation.

Regarding argument (B), applicant introduces limitation that reads, "While the presence information is monitored at the particular communication device".

In response to argument (B), examiner uses Maggenti's art in order to overcome the presented limitation. Explanations of the arguments are found in the office action above.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angelica Perez whose telephone number is 703-305-8724. The examiner can normally be reached on 7:15 a.m. - 3:55 p.m., Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and for After Final communications.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either the PAIR or Public PAIR. Status information for unpublished applications is available through the Private PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2600's customer service number is 703-306-0377.

  
Angelica Perez  
(Examiner)

  
NAY MAUNG  
SUPERVISORY PATENT EXAMINER

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December 22, 2004